DOCKET NO: SIEM0023U-USCP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: CONFIRMATION NO.:7313

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APPLICATION NUMBER: 09/513,462   EXAMINER: BACKER, F.

FILED: February 25, 2000

RECEIVED

JAN 0 7 2004

GROUP 3600

FOR: Method for Using Software Products that are Offered Via a Network

37 CFR 1.192 APPEAL BRIEF

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Sir:

This is an appeal from the final rejection mailed September 24, 2003, of claims 1 and 3-

15. A Notice of Appeal was timely filed December 23, 2003. The claims on appeal are set forth

in the Appendix.

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I.   **37 CFR 1.192(a)**

This brief is filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II.   **37 CFR 1.192(b)**

The filing is timely. Accordingly, this subsection is not relevant.

III.   **37 CFR 1.192(c)**

A.   **37 CFR 1.192(c)(1) Real party in interest**

The real party in interest is SIEMENS Aktiengesellschaft, a German corporation.

B.   **37 CFR 1.192(c)(2) Related appeals and interferences**

There are no related pending appeals, pending interferences, or requests for interferences known to the appellant's representative or the appellant's assignee.

C.   **37 CFR 1.192(c)(3) Status of claims**

Claims 1 and 3-15 are pending, rejected, and under appeal.

D.   **37 CFR 1.192(c)(4) Status of amendments**

All amendments are entered.

E.   **37 CFR 1.192(c)(5) Summary of the invention**

The invention of claim 1 is a method for using software products that are offered via a network, comprising: inquiring about a software product from an offer server by a user via a terminal device (page 7 lines 11-15); downloading said software product from said offer server via said network onto said terminal device in response to said inquiring by said user (page 7 lines 14-15; page 12 lines 16-23); activating a software component of said software product (page 7 lines 16-19; page 12 line 28 to page 13 line 7); starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user, wherein said usage processing server is operated by a network provider (page 7 lines 16-19; page 13 lines 8-9); providing, by said software component in a framework of said communication, data to said usage processing server; (page 7 lines 23-26; page 9 lines 5-15) and checking said data, by said usage processing server (page 7 line 27 to page 8 line 8; page 13 lines 9-12), and then making a determination selected from a group consisting of: whether usage of said software product is

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approved with respect to said inquiring user (page 8 lines 9-14), and whether charging operations are carried out on user accounts and provider of software product accounts (page 8 lines 15-22; page 13 lines 13-15; page 12 line 17 to page 14 line 9). Claim 3 recites the method of claim 1, further comprising operating said offer server by a network provider (page 7 lines 4-10). Claim 4 recites the method of claim 1, further comprising using a web server for a server selected from the group consisting of said offer server and said usage processing server (page 7 lines 4-10).

The invention of claim 5 is a usage processing server comprising: a usage processing module for processing a software product downloaded from a network (page 7 lines 4-10); wherein said usage processing server is operated by a network provider (page 7 lines 16-19; page 13 lines 8-9) and wherein said usage processing server is contacted by said software product after said software product has been downloaded into a terminal device of a user and has been activated (page 7 lines 16-19; page 12 line 28 to page 13 line 7); and wherein usage processing data required to perform usage processing are delivered to said usage processing server (page 7 lines 23-26; page 9 lines 5-15). Claim 6 recites a usage processing server according to claim 5, further comprising: a data store in which a software product identification of said software product and type of usage processing data that prescribe a type of usage processing of said software product are stored by said usage processing module, and wherein said usage processing module registers said software product (page 7 line 27 to page 8 line 7). Claim 7 recites a usage processing server according to claim 5, wherein: said usage processing data required comprises a software product identification of said software product and a user identification (page 7 line 27 to page 8 line 7). Claim 8 recites a usage processing server according to claim 5, wherein: said usage processing comprising performing an access control (page 8 lines 9-14). Claim 9 recites a usage processing server according to claim 5, wherein: said usage processing comprises performing a usage charging of said software product on user accounts and provider accounts (page 9 lines 15-22). Claim 10 recites a usage processing server according to claim 5, wherein: said usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts (page 9 lines 23-25).

The invention of claim 11 is a software product, comprising: a software component that is activated when called by said software product (page 7 lines 16-19; page 12 line 28 to page 13

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line 7) and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to said usage processing server in the framework of said communication, wherein said usage processing server is operated by a network provider (page 7 lines 23-26; page 9 lines 5-15); wherein said software product can be downloaded into a terminal device by a user via a network in response to an inquiry from said user (page 7 lines 11-15). Claim 12 recites a software product according to claim 11, wherein said usage processing data comprises: software product provider data; software product identification; and wherein said usage processing data is dynamically determined user data (page 7 line 27 to page 8 line 8). Claim 13 recites a software product according to claim 12, wherein said software component interacts with said user to produce said dynamically determined user data (page 9 lines 11-12).

The invention of claim 14 is a method for the generation of a software product that is offered via a network, comprising: installing a software component in source code of said software product of a software manufacturer by using a software development kit provided by a usage processing provider (page 7 lines 14-15; page 12 lines 16-23); activating said software component when called by said software product (page 7 lines 16-19; page 12 line 28 to page 13 line 7); starting a communication by said software component with a usage processing server after said activating said software component, wherein said usage processing server is operated by a network provider (page 7 lines 16-19; page 13 lines 8-9); sending, by said software component, usage processing data that are required for performing usage processing to said usage processing server in the framework of said communication (page 7 lines 23-26; page 9 lines 5-15).

The invention of claim 15 is a method for using software products that are offered via a network, comprising: inquiring about a software product from an offer server by a user via a terminal device (page 7 lines 11-15); downloading said software product from said offer server via said network onto said terminal device in response to said inquiring by said user (page 7 lines 14-15; page 12 lines 16-23); activating a software component of said software product (page 7 lines 16-19; page 12 line 28 to page 13 line 7); starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response

to a call of said software product in said terminal device of said user (page 7 lines 16-19; page 13 lines 8-9); providing, by said software component in a framework of said communication, data to said usage processing server; (page 7 lines 23-26; page 9 lines 5-15) and checking said data, by said usage processing server (page 7 line 27 to page 8 line 8; page 13 lines 9-12), and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user (page 8 lines 9-14), and whether charging operations are carried out on user accounts and provider of software product accounts (page 8 lines 15-22; page 13 lines 13-15; page 12 line 17 to page 14 line 9).

F. **37 CFR 1.192(c)(6) Issues**

Whether the rejection of claims 1 and 3-15 under 35 USC 103(a) as being unpatentable over U.S. patent 6,282,711 to Halpern ("Halpern") in view of U.S. patent 5,925,127 to Ahmad et al. ("Ahmad") should be reversed.

G. **37 CFR 1.192(c)(7) Grouping of claims**

Group 1 consists of claims 1, 5, 6-8, 11, and 14. Group 2 consists of claim 3. Group 3 consists of claim 4. Group 4 consists of claim 9. Group 5 consists of claim 10. Group 6 consists of claims 12 and 13. Group 7 consists of claim 15.

H. **37 CFR 1.192(c)(8) Argument**

1. **The Rejections Under 103(a) of Independent Claim 1 - Group 1**

   a. **The Examiner's Arguments**

In support of the rejection of claim 1 under 35 USC 103(a) as being unpatentable over Halpern in view of Ahmad, the examiner states that:

> As per claims 1, Halpern et al teach a method of using software products that are offered via a network (see abstract, fig 1) comprising inquiring about a software (software components) product from an offer server (remote server, 102) by a user via a terminal device (client system 101) downloading (downloading) the software product from the offer server via the network onto the terminal device in response to the inquiry of the user (see abstract, fig 1, 2, column 4 lines 44-5 line 47) activating (installing) a software component (subset) of the software product; starting a communication by way of the software component with a usage processing server regarding a usage of the software product in response to a call of the software product in the terminal device of the user (see abstract, fig 1, 2, column 4 lines 44-5 line 47). [Office action mailed September 9, 2003, paragraph 3.]

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In rejecting claim 1, the examiner further states that:

> Halpern et al fail to teach an inventive concept of providing, by the software
> component in a framework of the communication, data to the usage processing
> server; and checking the data, by the usage processing server, and then making a
> determination selected from the group consisting of: whether usage of the
> software product is approved with respect to the inquiring user, and whether
> charging operations are carried out on user accounts and provider of software
> product accounts. [Office action mailed September 9, 2003, paragraph 3.]

In rejecting claim 1, the examiner further states that:

> However Ahamad [sic] teach an inventive concept of providing, by the software
> component in a framework of the communication, data to the usage processing
> server; and checking the data, by the usage processing server, and then making a
> determination selected from the group consisting of: whether usage of the
> software product is approved with respect to the inquiring user, and whether
> charging operations are carried out on user accounts and provider of software
> product accounts (see fig 3, column 9 line 5-12 line 10). [Office action mailed
> September 9, 2003, paragraph 3.]

b.   The Citations Relied Upon By the Examiner

The examiner relies upon the abstract of United States patent 6,282,711 to Halpern et al.

("Halpern"), which states that:

> This invention includes a method for more efficiently installing a subset of
> software components and data files contained in a component pool in a distributed
> processing network such as the Internet. An installation package delivered to a
> requesting end user is custom configured at a remote server location prior to
> delivery to a client system operated by the user, in response to the user's inputs.
> The delivered installation package contains only the programs, data, and local
> installation tools required for the user's unique installation requirements. The user
> initiates the installation process by connecting to the remote server system via a
> telecommunications link within a distributed processing network, such as the
> Internet. Engaging in a dialog with the server which provides informational links
> to server-side databases, the user chooses all software components and options
> that he desires his software package to have. Such a package may be, for example,
> a subset of a software suite. After selection of all options, a single package is
> manufactured on the server. A single download then occurs of a single file. This is
> no bigger or smaller than what is absolutely required by the components and
> options selected. Upon receipt of the downloaded file, the user executes the file to
> unpack the installation directory. An auto-start feature can also be included which
> immediately launches the installation of the selected applications and options.

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[Halpern abstract.]

In rejecting claim 1, the examiner further relies upon Halpern at column 4 line 44 to column 5

line 47, which states that:

> In order for a client system user to more efficiently install a subset of a pool of
> software components downloaded from a remote server system coupled to a
> distributed processing network such as the Internet, an installation package is
> custom configured at the server location so that it contains only the components
> and options requested by the user during a dialog with the server. In order to
> further reduce the amount of downloaded material, the installation tools are also
> pared down to only those needed for the installation of the ordered components
> and options.

> Referring now to FIG. 1, the installation process requires connection between a
> client system 101 and a remote server system 102 via a distributed processing
> network such as the Internet. A user initiates the installation process by
> establishing a telecommunications connection 103 to an options manager 104 via
> a user interface 106. The user interface 106 can be customized to fit the needs and
> sophistication of particular users. As an exemplary implementation, multiple user
> interface templates UI-1, UI-2 and UI-3 provide a remote, programmatically
> accessible framework for delivering a variety of customized UIs to regular users
> 105A, power users 105B and system administrators 105C, respectively. The user
> interface 106 can be implemented using one of many available standard graphical
> interface technologies, such as the X Window System for the Linux operating
> system, or one of the Internet technologies such as html, javascript, standard web
> browsers (e.g., Netscape Navigator or Internet Explorer), and javaserver
> applications on a remote server.

> Via the user interface 106, the user 105 engages in a dialog with the options
> manager 104, a server-resident program which manages selection of components
> from a component pool 107. The options manager 104 may access "meta data"
> from a component information database 108. Meta data is information which
> relates to the interdependency of components. If the user desires information
> related to a particular software component within the component pool 107, such
> information may be contained within the component information database 108, or
> the options manager may provide informational links to other server-side
> databases (not shown). Such links can be visible to and selectable by the user, or
> programmatic and hidden from the user. The options manager 104 may also
> obtain information about the contents or state of the component pool 107 by
> accessing it directly. If two separate storage entities (e.g., the component pool 107
> and the component information database 108) contain information about the same
> software components, integrity between the entities can be maintained either

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synchronously or asynchronously, depending on the implementation. The options manager 104 may also initiate a call back to the client environment or to the local network environment of the client so that a client agent 114 (in this case a discovery client agent), possibly downloaded from the server 102, may gather other installation-related information for the options manager 104, which may be useful in guiding a presentation of component selections to the user. The discovery client agent 114 interfaces with the options manager 104 via a programmatic front-end object 113. The front-end objects 113, which may be written in Java script, provide for an efficient, optimized interface which "front-ends" the entity being accessed. Examples of useful information may include a list of software components already installed in the client environment and the release version of those components and detected or suspected devices, such as printers, coupled to the client environment which may necessitate certain software installation modifications. The options manager 104 sends data back to the selected user interface template UI-1, UI-2 or UI-3 for presentation to the user. The user then selects the components and options that interest him/her. As an example of option selection, it may be desirable for a European user to want a printer driver pre-configured so that it defaults to A4-size paper, rather than the standard U.S. default size of 81/2.times.11. [Halpern at column 4 line 44 to column 5 line 47.]

In rejecting claim 1, the examiner further relies upon United States patent 5,925,127 to Ahmad ("Ahmad") at column 9 line 15 to column 12 line 10, which states that:

> FIG. 3 is a simplified block diagram illustrating the downloading of software program modules embodying an exemplary embodiment of the present invention from a remote server to a user's computer 20 via the Internet 60. Generally, as illustrated in FIG. 3, program modules available for rental are registered with a central registration site, such as a Software Registry 95. In the exemplary embodiment illustrated in FIG. 3, the Software Registry 95 is maintained on the program module rental server 88a. It should be understood that the Software Registry 95 may be maintained at a different location or remote server separate from the program module rental server 88a. It should also be understood that a variety of software program module owners or developers may register their program modules on the Software Registry 95 for rental to prospective users by the rental service provider. It should further be understood that any number of rental service providers may be authorized to rent a particular software program module which is registered with the Software Registry 95. Preferably, each rental service provider will rent that particular program module from their respective Internet servers.
>
> After the rental form is completed by the user, the rental service provider issues from the rental server 80a an instance of a Check-in/Check-out (CICO) module

120 corresponding to the particular program module 100 requested by the user. As is discussed in detail below, the CICO module 120 contains required licensing information for the program module requested by the user.

The program module 100 and the corresponding CICO module 120 are downloaded from the server 80a (in no particular order) to the user's computer 20 over the Internet 60, illustrated in FIG. 3, in a manner well known to those skilled in the art. Both modules are typically stored on the user's hard disk drive, or some other form of non-volatile memory storage device. As is well known to those skilled in the art, one or both of the modules (program module 100 and CICO module 120) can be compressed to expedite the downloading process. That is, the program module 100 may, if desired, be appended to the CICO module 120 to form one module. That one module may be downloaded to the user's computer 20, as described above.

Once the program module 100 and the CICO module 120 are downloaded onto the user's computer 20, the CICO module 120 provides the licensing information to a Software Monitor module 140 that is resident on the user's computer 20. In the case of a single module combining the CICO module 120 and the program module 100, the CICO module 120 will run first to provide the required licensing information to the Software Monitor module 140. As is discussed in detail below, the Software Monitor module is a software application that monitors and ensures that use of the rented program module 100 by the user is in accordance with the licensing information provided by the CICO module 120. The operation and interaction of the processes and software program modules embodying the present invention discussed above will now be discussed in detail.

Referring now to FIGS. 2 and 3, as discussed above, before a particular program module 100 may be rented, that program module 100 must be registered on a Software Registry 95, which is a central registration site which may be maintained on the rental service provider's server 88a or separately from the rental service provider's server 88a. In response to registration on the Software Registry, the Software Registry assigns the program module 100 a unique identification number (APPID). For example, Microsoft "Word," version 8.0, would receive an APPID. If the program module 100 already has an assigned APPID, the Software Registry 95 will register this pre-assigned APPID, which is typically provided by the manufacturer of the program module 100. For example, the APPID can be a "Global Unique Identifier code" (GUID) assigned to selected program module titles by software manufacturers.

The CICO module 120 is a software program module responsible for providing licensing information for the rented program module 100 to the Software Monitor module 140 (discussed below) resident on the user's computer 20. The licensing

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information contained by the CICO module 120 includes the APPID and the licensed period of time over which the program module 100 may by used. The CICO module 120 is a tool that will encode this information on the user's computer 20 so that the Software Monitor module 140 can be made aware of the user's permission to use the program module 100, as well as the time period over which use of the program module 100 is allowed. It should be understood that a CICO module 120 is downloaded each time a program module is rented or renewed.

The CICO module 120 must be run on the user's computer 20 prior to running the rented program module 100 on the user's computer 20. In the preferred embodiment, the CICO module 120 is downloaded from the rental server 88a via the Internet, as described above. The CICO module 120 is preferably implemented as a dynamic-link library module (DLL) or as an Active X/OLE module (OCX). These types of modules are well known to those skilled in the art as modules that serve a specific function or set of functions which may be launched only when needed by a program that calls them. Preferably, the CICO module 120 is launched upon being downloaded to the user's computer 20. The mechanism for downloading and launching the CICO module 120 from the Internet is well known to those skilled in the art.

Because the CICO module 120 is a software application itself, it must be made secure from unauthorized copying or tampering before it can assist in securing the rented program module. Each CICO module has a CICO module identification number (CID). The CID preferably has two parts separated by a "-". As is discussed in detail below, the first part of the CID is a unique identification number generated and encode into the CICO module by the Software Monitor module 140, and the second part is the identification number unique to the user's computer 20. The Software Monitor module 140 verifies the CICO module 120 has not been used before and then issues a randomly generated unique CID to the CICO module 120. After the CICO module 120 provides the Software Monitor module 140 with the licensing information for the rented program module 100, the CICO module 120 is deleted by the Software Monitor module 140 to prevent any unauthorized copying of the CICO module 120.

Upon downloading the program module 100 and the CICO module 120 onto the user's computer 20, the program module 100 will load the Software Monitor module 140 (SM) for operation. As should be understood from the foregoing discussion, the SM 140 is a software program module or module that verifies the user's license to use the rented program module and tracks use of the rented program module by the user. Referring to FIG. 3, the SM 140 may be downloaded from the rental server 80a to the user's computer 20 at the time the program module 100 and the CICO module 120 are downloaded. Alternatively, the SM

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140 may be resident on the user's computer 20 as part of software provided to the user on the computer's hard disk drive.

The SM 140 must run constantly on the user's computer 20 during use of the rented program module 100 to prevent unauthorized use of the rented program module 100. As with the CICO module 120, the SM 140 may be implemented as either a system DLL or an ActiveX control module. Once the CICO module 120 has been downloaded and secured by the SM 140, as discussed above, the CICO module 120 transfers to the SM 140 the license information for the rented program module. The data is transferred as bytes to the SM 140 in a manner well known to those skilled in the art. The SM 140 is responsible for interpreting and using the information. The task of the CICO module 120 is completed as soon as the information is transferred.

The SM 140 tracks the time of use of the program module 100 without the use of the computer's system clock because the computer's system clock may be easily changed by the user. The SM 140 utilizes an internal timer to track the actual elapsed time of use of the program module 100. The standard approach to calculating the time of use is to subtract the start time, i.e., the time the program module 100 is launched from the end time, i.e., the time the program module 100 is exited.

To further prevent the user from manipulating the system, the SM 140 may hook into the system clock of the computer 20 via the operating system, which offers system time and system date, to be notified each time the system clock is changed. Consequently, all changes to the system clock will be recorded and accounted for by the SM 140.

Alternatively, the SM 140 may track the number of uses of the program module 100 if the program module is rented for a specified licensed number of uses. The SM 140 may track the number of uses of the program module 100 by setting an internal counter, similar to the above-described internal timer, when the program module 100 is first used. Upon each subsequent licensed use, the counter will add one count. The SM 140 will compare the total count to the licensed number of uses each time the user attempts to launch the program module 100. After the licensed number of uses is expended the SM 140 will prevent subsequent operation of the program module 100.

For subsequent use of the program module 100, the SM 140 can remember that it deleted the CICO module 120 during the first use of the program module 100, and the SM 140 will not check for the CICO module 120 on the second (and future uses) of the program module 100 while time remains for use of the program module 100. For subsequent rental of the program module 100, there is no need to

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download the program module 100 again. However, there is a need to download the CICO module 120 again from the rental service provider's server each time the program module 100 is subsequently rented.

Unauthorized copying of the program module 100 is prevented by rendering the program module useless without the simultaneous operation of the Software Monitor 140. Because the program module 100 will not run without the simultaneous running of the SM 140, any unauthorized copy of the program module 100 launched on a different computer will be rendered useless because the SM 140 will recognize that the computer identifier for the different computer does not match the computer identifier stored as a part of the unique CID, described above. Accordingly, the SM 140 will not allow the unauthorized copy of the program module 100 to run. [Ahmad at column 9 line 15 to column 12 line 10.]

> c. **Disputed Factual Assertion - Ahmad Does Not Teach or Suggest "...a usage processing server...operated by a network provider..."**

The examiner asserts that:

...Ahmed [sic] teach[es] an inventive concept for a software module rental method and system that allow software applications to be rented on a pat-per-use [sic] from a rental service provider while allowing the rental service provider to monitor us of the rented software application. This is a clear indication that the usage processing server is operated by a network (service) provider....[Office action mailed September 24, 2003, at paragraph 16.]

That assertion is incorrect.

> i. **The Applicant's Definition of "Network Provider"**

The application's definition of "network provider" is clear from the following passage in the specification of this application:

The network operator (or "*network provider*") operates and administers a network that primarily provides a "bit-transport" functionality . The network operator provides network connectivity for the web servers of the provider of software and contents or he may assume this function vicariously by providing a web server for the provider ("web hosting") . The network operator also *provides network connectivity for the end user*, normally as dial-in via a modem or ISDN, and thus normally has an *established and long term business relationship with the end user*. He sends the end user invoices about received network connectivity performances on a regular basis and knows his financial actions. [Specification at

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page 1 lines 15-23; emphasis added.]

ii.   The Applicant's Definition of "Usage Processing"

The application's definition of "usage processing" is clear from the following passage in the specification of this application:

> According to the present invention, a service provider (e.g., the network operator) assumes the *usage processing*, (e.g., "*charging and/or access control*") for the usage of software and contents. The network operator offers this as a service for the provider of software and contents, when the provider wishes to "outsource" these tasks in order to be able to concentrate on the preparation of software and contents.The provider of software and contents can also avoid the *charging of very small amounts*, which may not be economical for him, via "outsourcing".
>
> Providing *usage processing*, such as *charging and/or access control*, is particularly advantageous for the network operator since the end user is already connected to the network of the network operator for purposes of the network connectivity, and therefore is in a *long term business relationship* with the network operator. [Specification at page 4 lines 1-13; emphasis added.]

iii.   Ahmad's "Web Server" Is Not the Claimed "Network Provider"

Ahmad discloses at column 8 lines 1-38 that:

...The Internet 60 includes a plurality of backbone networks 65a through 65n. These backbone networks form an international grid of high-speed, high-capacity data communication lines interconnecting a number of massive computers that serve as large-scale processing points or nodes. The backbone networks 65 are interconnected with each other through a plurality of network access points 70a through 70n. These network access points are interfaces through which information is communicated from one backbone network to another....

> The Internet 60 includes a plurality of *Internet sites* 75a through 75n. These Internet sites are generally *operated by corporations, universities, and governmental organizations*. Each Internet site may include one or more repositories of information and resources that may be accessed over the Internet. Each Internet site, as represented by the Internet site 75a, may include a plurality of *web servers* 80a through 80n. Each of these web servers may provide "home pages" to be visited, files to be read or downloaded, *applications to be shared*, and the like. [Ahmad at column 8 lines 1-38; emphasis added.]

> The Internet 60 also includes a plurality of *points of presence* 85a through 85n that are *operated by local access providers*. These local access providers are in the business of *providing Internet access to end user stations*. In the preferred

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embodiment of the present invention, the personal computer 20, shown in FIG. 1, is an end-user station. As shown in FIG. 2, the point of presence 85a provides Internet access to the personal computer 20 (end user station) and other end user stations 88a through 88n, the point of presence 85b provides Internet access to end user stations 88a' through 88n', etc. All together, the points of presence 85 can provide Internet access to numerous end-user stations 88. Each point of presence 85, and each end user 88, may, but need not, provide home pages for access by others on the Internet 60. [Ahmad at column 8 lines 1-38; emphasis added.]

Clearly, Ahmad's "Internet sites" and "web servers" are not designed to provide network connectivity for the end user. In contrast, Ahmad's Internet sites and web servers are designed to provide "repositories of information" and to be "operated by corporations, universities, and governmental organizations."

<div align="center">

iv.   **Ahmad Only Discloses "Applications to be Shared" and a "Rental Service Provider" Residing on His "Web Server"**

</div>

It is clear that the only components in Ahmed's system designed to provide shared applications, that is, applications that may be downloaded from the Internet, are Ahmad's Internet sites and web servers:

Each Internet site, as represented by the Internet site 75a, may include a plurality of *web servers* 80a through 80n. Each of these web servers may provide "home pages" to be visited, files to be read or downloaded, *applications to be shared*, and the like. [Ahmad at column 8 lines 1-38; emphasis added.]

It is also clear that the only components in Ahmed's system designed to provide a "rental service" are Ahmad's Internet sites and web servers:

Referring now to FIG. 2, a user desiring to rent a particular program module, logs onto the Internet, as discussed above, and accesses the *Internet site 75a of the software rental service provider*. The user then locates the *rental server 80a at the Internet site 75a*. The user completes a rental form provided on the server 80a and requests use of a particular program for a specified period of time. It should be understood that the form can also require payment information, such as a credit card number or an account number if the user has an established account with the rental service provider. [Ahmad at column 8 lines 54-64; emphasis added.]

Therefore, the only component of Ahmed's system that could possibly have been

recognized by one of ordinary skill in the art as the claimed "usage processing server" would have been Ahmed's "web servers" operated by Ahmed's "Internet sites." No other component in Ahmad's disclosed system has the capability to function as the claimed "usage processing server." Most importantly, Ahmad does *not* disclose that his "points of presence 85a through 85n" provide "applications to be shared" or a "rental service provider."

> **v.   Only Ahmad's "Points of Presence" May Function As the Claimed "Network Provider"**

In Ahmad's system, the only component which would have been recognized by one of ordinary skill in the art as being the claimed "network provider" would have been Ahmed's points of presence:

> The Internet 60 also includes a plurality of *points of presence* 85a through 85n that are *operated by local access providers*. These local access providers are in the business of *providing Internet access to end user stations*. [Ahmad at column 8 lines 24-28; emphasis added.]

Thus, Ahmad clearly distinguishes the functionality of his "points of presence 85a through 85n" from his "Internet sites 75a through 75n" and his "web servers 80a through 80n" because only Ahmed's "point of presence" provide Internet access to "end user stations." In contrast, as noted above, Ahmad's Internet sites and web servers are designed to provide "repositories of information" and to be "operated by corporations, universities, and governmental organizations."

> **vi.   Ahmad Does Not Disclose That His "Points of Presence" Provide "Applications to be Shared" or a "Rental Service Provider"**

As noted above, Ahmad only discloses that web servers 80a-80n provide "applications to be shared" and a "rental service provider." Ahmad does *not* disclose that his "points of presence 85a through 85n" provide either "applications to be shared" or a "rental service provider."

Therefore, there is no teaching in Ahmad that suggests "...a usage processing server...operated by a network provider...," recited by claim 1 and defined in this application. Therefore, Ahmad in combination with Halpern does not suggest the subject matter of claim 1.

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d.   The Applicant's Traversal of the Rejection: No Motivation to

Combine References

i.   Ahmad's System Is Designed to Control Complete

Programs

Ahmad's disclosed system is directed to controlling the use of complete programs:

> The present invention is directed to a method and system for monitoring the use of a rented software program module by a rental service provider of that software program module. As will be understood, the present invention may be used for monitoring a variety of program modules, such as *application programs*, operating system modules, Internet browsers, etc. In an exemplary embodiment of the present invention, an *application program*, such as "WORD," version 8.0, produced by Microsoft Corporation of Redmond, Wash., may be rented by an end user for use during some specified period of time. The present invention allows a rental service provider to track the use of the rented software program module to prevent unauthorized extension of a licensed period of use and to prevent unauthorized copying of the rented software program module. [Ahmad at column 5 lines 16-30; empha

ii.   Halpern's System Is Designed to Control Components

of Complete Programs

In contrast to the system disclosed by Ahmad, Halpern's system is directed to the control

of individual software components which, when properly installed, form a complete functioning

program:

> This invention includes a method for more *efficiently installing* a *subset of a pool of software components* in a distributed processing network such as the Internet. An installation package delivered to a requesting user is *custom configured* at a remote server location prior to delivery to the user, *in response to the user's inputs*. The delivered installation package contains only the programs, data, and local installation tools required for the user's unique installation requirements. [Halpern at column 2 line 66 to column 3 line 7; emphasis added.]

> The primary advantages of the new software installation process are: it permits a user to obtain the software he wants without having to download extraneous program files; it permits users to learn about the functionality of individual software components and to *select desired software components without having to download unnecessary code and/or data, or an installer agent program;*and it allows a software vender to supply packages smaller than an entire application suite, thereby increasing demand for its products because the user pays only for

what he orders and uses, and providing the vender with more accurate information with regard to which software components are actually being used. [Halpern at column 4 lines 19-31;

iii. Ahmad's System Is Not Compatible With Halpern's System

Because Ahmad's system is disclosed as only operable with complete programs, such as "WORD," version 8.0, one of ordinary skill in the art at the time of the invention would have recognized that attempting in incorporate Ahmad's system into Halpern's system would have inhibited the ability of a user of the combined system to *"select desired software components without having to download unnecessary code and/or data, or an installer agent program."* Further, because each software component of "custom configured" software would have to "rented" separately, a user of a combined Halpern/Ahmad system would be confronted with a needlessly complex bill.

Therefore, one of ordinary skill in the art would *not* have been motivated to combine the teachings of Ahmad with the teachings of Halpern. Because there is no teaching or suggestion to combine the teachings of Ahmad with the teachings of Halpern, the examiner has not made a proper *prima facie* rejection. Therefore, the rejection of claim 1 is improper and should be reversed.

e. The Applicant's Traversal of the Rejection: References Do Not Disclose or Suggest "...a usage processing server...operated by a network provider..."

Claim 1 recites "...a usage processing server...operated by a network provider..." For the reasons stated above, neither Halpern nor Ahmad disclose or suggest "...a usage processing server...operated by a network provider...". Therefore, the rejection of claim 1 is improper and should be reversed.

2. **The Rejections Under 103(a) of Independent Claims 5, 11, and 14 - Group 1**

   a. **The Examiner's Argument**

The examiner's arguments in rejecting claims 5, 11, and 14 are substantially the same as for claim 1 above.

   b. **The Citations to Halpern and Ahmad Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claims 5, 11, and 14 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

   c. **The Applicant's Traversal of the Rejections**

In reply, the applicant respectfully traverses these rejections for the same reasons noted above for claim 1 because they are not supported by either substantial evidence or proper legal conclusions. Claim 5 recites a "usage processing server...operated by a network provider." Claim 11 recites "a usage process server...operated by a network provider." Claim 14 recites "a usage processing server...operated by a network provider." For the reasons just stated, neither Halpern nor Ahmad discloses or suggests "...a usage processing server...operated by a network provider...". Therefore, claims 5, 11, and 14 are patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claim 1. Therefore, the rejections of claims 5, 11, and 14 are improper and should be reversed.

3. **The Rejections Under 103(a) of Dependent Claims 6-8 - Group 1**

   a. **The Citations Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claims 6-8 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

   b. **Claims 6-8 - Dependency On Allowable Claims**

In reply, the applicant respectfully traverses these rejections because they are not supported by either substantial evidence or proper legal conclusions. The rejected claims depend directly from claim 5. Therefore, the rejected claims are patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14. Therefore, the rejections of claims 6-8 are improper and should be reversed.

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4. **The Rejection Under 103(a) of Dependent Claim 3 - Group 2**

   a. **The Citations Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claim 3 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

   b. **Claim 3 - Dependency On An Allowable Claim**

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. The rejected claim depends directly from claim 1. Therefore, the rejected claim is patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14.   Therefore, the rejection of claim 3 is improper and should be reversed.

   c. **Claim 3 - Halpern and Ahmad Do Not Teach or Suggest "...operating said offer server by a network provider..."**

Claim 3 recites "...operating said offer server by a network provider...." The citation to Ahmad relied upon by the examiner in rejecting claim 3 does not disclose or suggest "...operating said offer server by a network provider...." Therefore, claim 3 is patentably distinguishable over Halpern and Ahmed. Therefore, the rejection of claim 3 is improper and should be reversed.

5. **The Rejection Under 103(a) of Dependent Claim 4 - Group 3**

   a. **The Citations Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claim 4 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

   b. **Claim 4 - Dependency On An Allowable Claim**

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. The rejected claim depends directly from claim 1. Therefore, the rejected claim is patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14. Therefore, the rejection of claim 4 is improper and should be reversed.

c.   **Claim 4 - Halpern and Ahmad Do Not Teach or Suggest "...a server selected from the group consisting of said offer server and said usage processing server..."**

Claim 4 recites "...a server selected from the group consisting of said offer server and said usage processing server...." The citation to Ahmad relied upon by the examiner in rejecting claim 4 does not disclose or suggest "...a server selected from the group consisting of said offer server and said usage processing server...." Therefore, claim 4 is patentably distinguishable over Halpern and Ahmed. Therefore, the rejection of claim 4 is improper and should be reversed.

6.   **The Rejection Under 103(a) of Dependent Claim 9 - Group 4**

a.   **The Citations Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claim 9 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

b.   **Claim 9 - Dependency On An Allowable Claim**

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. The rejected claim depends directly from claim 5. Therefore, the rejected claim is patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14.

c.   **Claim 9 - Halpern and Ahmad Do Not Teach or Suggest "...performing a usage charging of said software product on user accounts and provider accounts..."**

Claim 9 recites "...performing a usage charging of said software product on user accounts and provider accounts...." The citation to Ahmad relied upon by the examiner in rejecting claim 9 does not disclose or suggest "....performing a usage charging of said software product on user accounts and provider accounts...." Therefore, claim 9 is patentably distinguishable over Halpern and Ahmed. Therefore, the rejection of claim 9 is improper and should be reversed.

7.   **The Rejection Under 103(a) of Dependent Claim 10 - Group 5**

a.   **The Citations Relied Upon By the Examiner**

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claim 10 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

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b. Claim 10 - Dependency On An Allowable Claim

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. The rejected claim depends directly from claim 5. Therefore, the rejected claim is patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14.

c. Claim 10 - Halpern and Ahmad Do Not Teach or Suggest a "...usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts..."

Claim 10 recites a "...usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts...." The citation to Ahmad relied upon by the examiner in rejecting claim 10 does not disclose or suggest a "...usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts...." Therefore, claim 10 is patentably distinguishable over Halpern and Ahmed. Therefore, the rejection of claim 10 is improper and should be reversed.

8. The Rejections Under 103(a) of Dependent Claims 12 and 13 - Group 6

a. The Citations Relied Upon By the Examiner

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claims 12 and 13 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

b. Claims 12 and 13 - Dependency On An Allowable Claim

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. The rejected claims depend directly or indirectly from claim 11. Therefore, the rejected claims are patentably distinguishable over Halpern and Ahmad for at least the reasons given above for claims 1, 5, 11, and 14.

c. Claims 12 and 13 - Halpern and Ahmad Do Not Teach or Suggest "...dynamically determined user data..."

Claims 12 and 13 recite "...dynamically determined user data...." The citation to Ahmad relied upon by the examiner in rejecting claims 12 and 13 does not disclose or suggest a

"...dynamically determined user data...." Therefore, claims 12 and 13 are patentably distinguishable over Halpern and Ahmed. Therefore, the rejections of claims 12 and 13 are improper and should be reversed.

9. The Rejection Under 103(a) of Independent Claim 15 - Group 7

a. The Citations Relied Upon By the Examiner

The citations to Halpern and Ahmad relied upon by the examiner in rejecting claim 15 are included in the citations to Halpern and Ahmad used in rejecting claim 1 above.

b. The Applicant's Traversal of the Rejection: No Motivation to Combine References

In reply, the applicant respectfully traverses this rejection because it is not supported by either substantial evidence or proper legal conclusions. One of ordinary skill in the art at the time of the invention would not have been motivated to combine the teachings of Halpern with the teachings of Ahmad for the reasons given above for claim 1. Therefore, the examiner has not made an proper *prima facie* rejection. Therefore, the rejection of claim 15 is improper and should be reversed.

IV. 37 CFR 1.192(d) - Non-compliant Brief

This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

Respectfully Submitted,

_12/31/2003_
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V. Appendix - Claims On Appeal

1. A method for using software products that are offered via a network, comprising:

inquiring about a software product from an offer server by a user via a terminal device;

downloading said software product from said offer server via said network onto said terminal device in response to said inquiring by said user;

activating a software component of said software product;

starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user, wherein said usage processing server is operated by a network provider;

providing, by said software component in a framework of said communication, data to said usage processing server; and

checking said data, by said usage processing server, and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts.

2. (Canceled)

3. The method of claim, further comprising operating said offer server by a network provider.

4. The method of claim 1, further comprising using a web server for a server selected from the group consisting of said offer server and said usage processing server.

5. A usage processing server comprising:

a usage processing module for processing a software product downloaded from a network;

wherein said usage processing server is operated by a network provider and wherein said usage processing server is contacted by said software product after said software product has been downloaded into a terminal device of a user and has been activated; and

wherein usage processing data required to perform usage processing are delivered to said usage processing server.

6. A usage processing server according to claim 5, further comprising:

a data store in which a software product identification of said software product and type of usage processing data that prescribe a type of usage processing of said software product are stored by said usage processing module, and

wherein said usage processing module registers said software product.

7. A usage processing server according to claim 5, wherein:

said usage processing data required comprises a software product identification of said software product and a user identification.

8. A usage processing server according to claim 5, wherein:

said usage processing comprising performing an access control.

9. A usage processing server according to claim 5, wherein:

said usage processing comprises performing a usage charging of said software product on user accounts and provider accounts.

10. A usage processing server according to claim 5, wherein:

said usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts.

11. A software product, comprising:

a software component that is activated when called by said software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to said usage processing server in the framework of said communication, wherein said usage processing server is operated by a network provider;

wherein said software product can be downloaded into a terminal device by a user via a network in response to an inquiry from said user.

12. A software product according to claim 11, wherein said usage processing data comprises:

software product provider data;

software product identification; and

wherein said usage processing data is dynamically determined user data.

13. A software product according to claim 12, wherein said software component interacts with said user to produce said dynamically determined user data.

14. A method for the generation of a software product that is offered via a network, comprising:

installing a software component in source code of said software product of a software manufacturer by using a software development kit provided by a usage processing provider;

activating said software component when called by said software product;

starting a communication by said software component with a usage processing server after said activating said software component, wherein said usage processing server is operated by a network provider;

sending, by said software component, usage processing data that are required for performing usage processing to said usage processing server in the framework of said communication.

15. A method for using software products that are offered via a network, comprising:

inquiring about a software product from an offer server by a user via a terminal device;

downloading said software product from said offer server via said network onto said terminal device in response to said inquiring by said user;

activating a software component of said software product;

starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user;

providing, by said software component in a framework of said communication, data to said usage processing server; and

checking said data, by said usage processing server, and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts.

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Printed: December 31, 2003 (12:08pm)
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